

## Remarks

Claims 1-8 are pending. Amendments are entered herein to the specification and claims 1, 2, 5 and 6. No new matter is entered. The abstract is amended to conform to the requirements of MPEP § 608.01(b).

### **35 U.S.C. § 112, ¶2**

Claims 1- 8 are rejected under 35 U.S.C. § 112, ¶2 as being indefinite. The preambles of claims 1 and 5 are amended for clarification to remove the “illustrating” reference and now recite a method/system for analyzing college savings plans. The college savings plan analysis aspect of claims 1 and 5 is provided in step (c) of claim 1 and mechanism (d) of claim 5. Withdrawal of the § 112, ¶2 rejection of claims 1 and 5, and respective dependent claims 2-4 and 6-8 is respectfully requested.

Claims 2 and 6 are further rejected under 35 U.S.C. § 112, ¶2 as indefinite. The Office Action states that the:

limitation specifying a Section 529 of the U.S. Internal Revenue Code renders the claim indefinite. Section 529 is a code, which periodically is updated with changes and therefore makes it transitory-in-nature. Upon each update of the Section 529 code, the scope of the instant application would be altered and would be transitory-in-nature as well. Consequently the Section 529 limitation without a set-in-stone definition renders the metes and bounds of the claim confusing. (Office Action, page 3)

The reference to a specific section of the Internal Revenue Code (“IRC”) (*i.e.*, “Section 529 of the U.S. Internal Revenue Code”) has been removed from claims 2 and 6, which now refer just to a “section 529 plan.” Section 529 plans are well known in the art and are described, in detail, throughout the specification, for example, in the background section. It is noted that other United States patents have issued which refer in their claims to plans developed according to sections of the IRC, such as 401(k) plans, 401(a) plans, 403(b) plans, 457 plans, etc. See, e.g., U.S. Patent Nos.: 7,113,913, 7,155,407, 6,868,389, 6,826,541, and 6,473,737. Withdrawal of the § 112, ¶2 rejection of claims 2 and 6, and respective dependent claims 3-4 and 7-8 is respectfully requested.

**35 U.S.C. § 101**

Claims 1-8 are rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility. Claim 1 is amended to recite step (d) “outputting a report of the comparative analysis.” It is submitted that claim 1 as amended has patentable utility and provides a concrete result: an output of a report. Examples of reports are described throughout the specification, e.g., Abstract, Figs. 21-22, Appendix A, etc. Claim 5 is similarly amended. Withdrawal of the 35 U.S.C. § 101 rejection of claims 1 and 5, and dependent claims 2-4 and 6-8 is respectfully requested.

**35 U.S.C. § 103(a)**

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as obvious in view of Yinbal (U.S. Patent No. 6,424,952). This rejection is respectfully traversed.

The Office Action states that the limitation of claim 1 (wherein the comparative analysis takes into account one or more taxation implications for at least one of the educational savings plans) “is not given patentable weight because the limitation of taking into account one or more taxation implications for at least one of the educational savings plans has not been positively recited.” Applicants respectfully traverse this point.<sup>1</sup> However, to advance prosecution of the claims, claim 1 is amended to remove “wherein.”

The Office Action at page 7 states that Yinbal “does not explicitly teach the limitation of ‘wherein the comparative analysis takes into account one or more taxation implications for at least one of the educational savings plans.’” Indeed, there is no discussion in Yinbal of any educational savings plans, much less tax issues or tax implications of such educational savings plans. Yinbal merely describes providing a means to pay for educational expenses using calculations of future expected education fees and expected investment returns in a typical investment – not educational savings-specific investments. Thus, claim 1 is allowable over Yinbal. Claims 2-4 which depend from claim 1 are also allowable for at least the same reasons.

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<sup>1</sup> MPEP § 2111.04 states that claim scope “is not limited by claim language that *suggests or makes optional but does not require steps to be performed*, or by claim language that does not limit a claim to a particular structure,” and identifies several examples of claim language, including ‘wherein’ which “*may raise a question as to the limiting effect of the language in a claim.*” Thus, usage of the term ‘wherein’ does not automatically affect claim scope. “Determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case.” *Id*

Claim 5 is allowable over Yinbal for the reasons discussed above with reference to claim

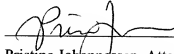
1. Claims 6-8 which depend from claim 5 are also allowable for at least the same reasons.

For the above reasons, reconsideration and withdrawal of the rejections of claims 1-8 is respectfully requested. Please charge any fees due for this response to Deposit Account No. 50-0310.

Respectfully submitted,

Dated

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